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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,369	06/14/2000	ERIC BARLOW	61512/CCD/RS	9882

7590 02/27/2002

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EXAMINER
OSORIO, ENRIQUE F

ART UNIT	PAPER NUMBER
1775	6

DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/508,369	BARLOW ET AL.	
	Examiner	Art Unit	
	Enrique F Osorio	1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 June 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) *15-21* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-21* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☒ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-14, drawn to an aluminum workpiece.

Group II, claim(s) 15-21, drawn to a method of treating an aluminum workpiece.

The inventions listed as Group I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature of an aluminum workpiece having on a surface thereof an anodic oxide film and a coating which consists essentially of at least one adhesion promoter, providing that promoters based on silicon-organic compounds are excluded is disclosed by US 3935349A, US 5439747A, and EP 0426328A. See International Search Report. Therefore, the special technical feature does not provide a contribution over the prior art.

2. During a telephone conversation with Richard S. Milner on January 29, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claim1-14. Affirmation of this election must be made by applicant in replying to this Office action.

Claim15-21 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6, 7, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Wieserman et al.(5,126,210).

Regarding claim 1: Wieserman teaches of a valve comprising an aluminum surface which has been anodized to form an aluminum oxide on said surface (col.1, line 43 and col. 3, lines 3-5), a functionalized layer (col.6, line 67) which can be used to improve adhesion bonding of polymers (col. 7, line 21).

Regarding claim 2 and 3: Wieserman teaches of an aluminum sheet (col.3, line 42) with an adhesion promoter coating which can provide an excellent surface for adhesion of paints (col. 7, lines 47-49).

Regarding claim 4 and 10: Weiserman teaches a film thickness of 560-840 angstroms (about 56 to 84 nm). See example 6.

Regarding claim 6: Wieserman teaches of a painted aluminum sheet for architectural use (col.7, line 48).

Regarding claim 7: Wieserman teaches of an aluminum workpiece wherein the adhesion promoter is polystyrene (col. 7, line 31).

Regarding claim 9: Wieserman teaches of an aluminum sheet (col. 3, line 42) with and adhesion promoter coating which can provide an excellent surface for adhesion of paints (col. 7, lines 47-48).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wieserman et al (5,126,210) in view of Wefers et al (5,238,715).

Regarding claims 4 and 10: Wieserman does not teach of said oxide film having a thickness of 10 to 200 nm (col. 9, line 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the thickness, as taught by Wefers, in the device of Wieserman because the anodic oxide thickness can be modified as desired by the user.

7. Claims 5, 8, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wieserman in view of Wefers as applied to claims 4 and 10 above, and further in view of Totsuka et al (5,395,687)..

Regarding claims 5 and 11: The device of Wieserman, as anticipated by Wefers, does not teach of an adhesive promoter coating having a weight of 2 to 500 mg/m2.

Totsuka teaches of an adhesion promoter coating with a weight of from 5 to 100 mg/m2 (col. 7, lines 48-56) to provide consistent coverage and improved corrosion resistance. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the weight of 5 to 100 mg/m2, as taught by Totsuka, in the device of the combined references of Wieserman and Wefers to provide the coverage necessary to obtain the required corrosion resistance.

Regarding claim 8: The device of Wieserman, as anticipated by Wafers, does not teach of an adhesion promoter containing one or more of Cr, Mn, Mo, Si, Ti and Zr.

Totsuka teaches a chromate film deposited on an aluminum substrate, the chromate layer providing an improved corrosion resistance and adhesion with the overlying layer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the chromate layer, as taught by Totsuka, in the device of the combined references of

Wieserman and Wefers with an expectation that improved corrosion resistance and adhesion will occur

Regarding claim 13: Ultimate intended use does not provide a patentable distinction over the art; however, Totsuka teaches a similar plate comprising aluminum for automobile use. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the plate, as taught by the combined references of Wieserman,Wefers, and Totsuka absent evidence to the contrary.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wieserman in view of Wefers and Totsuka.

Regarding claim 14: The device of Wieserman, as anticipated by Wefers and Totsuka, does not include an aluminum workpiece comprising a paint layer of an electro-conductive paint primer however Totsuka teaches the inclusion of an organic resin mixture film which includes electro-conductive finely divided particles (col. 5, lines 45+) similar to paint. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the electro-conductive layer, as taught by Totsuka, in the combined device of Wieserman and Wefers, because layers of an electro-conductive paint primer are well known to be used on an aluminum workpieces as shown by Totsuka.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Enrique F Osorio whose telephone number is (703) 305-3440, whose office hours are Monday through Thursday from 8:30 am to 6:00 pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuscceful, the examiner's supervisor, Deborah Jones can be reached at (703) 308-3822.

Enrique F. Osorio

February 14, 2002.

DEBORAH JONES
SUPERVISORY PATENT EXAMINER